

Claim 43, line 29, change "channel select designations" to --channel tuning designations which have one of said marker bits associated therewith--; lines 30, change "channel select designations" to --channel tuning designations--; line 34, change "channel select designation" to --channel tuning designation which has one of said marker bits associated therewith--; line 35, change "channel select designation to --channel tuning designation--; line 37, change "channel select designations" to --channel tuning designations which have one of said marker bits associated therewith--.

Claim 50. line 18, change "processor" to --channel tuning control--.

Remarks

The foregoing amendments are made responsive to the Office action dated March 4, 1996.

The Examiner has objected to the declaration as defective, and rejected claims 6-56 under 35 USC 251. The Examiner has stated that Applicant has failed to point out how errors arose in the Reexamination of Patent No. 5,068,734. There is no allegation that errors arose in the reexamination of the '734 patent. Respectfully, Applicant points out that this application is a

broadening reissue, and that claims of the scope presented here could not have been presented in that proceeding.

However, Applicant does recognize that claims presented in this application could have been presented in either the original application for the '734 patent or in the application for the '947 patent. Submitted herewith is a substitute Declaration in which it is stated that:

I verily believe the ['947 patent] to be partly inoperative or invalid by reason of the Patentee claiming less than Patentee had a right to claim in the '947 patent.

Such subject matter was also not claimed in the '734 patent or its reexamination. *Substitute Declaration, p. 2.*

With respect to the changes made to the claims, it is also stated that:

The foregoing changes are being made because I claimed less than I had a right to claim in either the '947 or '734 patents. *Substitute Declaration, p. 27.*

Thus, Applicant is alleging errors made in the prosecution of both the '947 and '734 patents.

As discussed in greater detail below, the Substitute Declaration also corrects the various discrepancies noted by the Examiner between the claim changes as identified in the Declaration and as actually appearing in the claims (as now amended).

Claims 6, 20 and 29 have been rejected under 35 USC 112, first paragraph as not supported by the specification as originally filed. It is noted that a similar claim was permitted in the reexamination of the '734 patent. However, to expedite the prosecution of this application, Applicant has simply cancelled these claims, thereby rendering this ground for rejection moot.

The Examiner has noted a number of minor distinctions between the claims as set out in the application (and amendments) and those claims as identified in the declaration. The distinctions appeared inadvertently as the various papers were prepared, and have been resolved as follows.

With regard to claims 7 and 30, the claims have been amended to change "each" to "at least one" to correspond to the declaration.

For claim 16, the new substitute declaration uses the term "marker" as used in claim 16. In claim 32, the claim has been amended to change "after" to "upon" to correspond to the declaration.

The Examiner has rejected claims 16-31, 33-37, 42, 43, 50, 55 and 56 under 35 USC 112, second paragraph as indefinite. Accordingly, claims 16, 28, 37, 42 and 43 have been amended to delete "said channel select designations" and replace this language

with "said channel tuning designations which have one of said marker bits associated therewith." This language differs slightly from that proposed by the Examiner, but provides the necessary antecedent basis for the claim terms and is believed to describe more accurately the functioning of the device.

Claims 17, 30 and 50 have been amended to delete "said processor signal" in the manner suggested by the Examiner. Claim 33 has been amended to change "said memory means" to "said memory." Claim 5 has been amended in the manner suggested by the Examiner to provide antecedent basis for claim 55.

With respect to claim 56, it is respectfully submitted that "first control output signal" and "desired channel select designation" do not represent the same thing, although they are related. A channel select designation is a representation of a tuning channel, usually represented by numerals (e.g. "17") or letters (e.g. "TBS"). The first control output signal is the electronic output signal generated by the control means that carries the data representing the select designation. Claim 56 specifies that one person chooses the select designation to be used, while another manipulates the control means to cause the first control output signal to be generated.

Claims 17-31 and 33-37 have been rejected on the basis that the phrase "in response to" is indefinite. Specifically, the

Examiner has questioned whether there is any distinction between that language and the phrase "upon receipt of." It is submitted that the language "in response to" is broader language, at least with respect to a control signal and a processor that carries out instructions. The language "in response to" requires only a cause-and-effect relationship between the signal and the processor, and may be satisfied, for example, where the signal is actually received by some intermediary device which in turn signals the processor.

Claims 56 and 17-31 and 33-37 are therefore not believed to be indefinite.

Claims 13 and 26 have been rejected under 35 USC 102(b) as anticipated by U.S. Pat. No. 4,600,918 (Belisomi), with the Examiner taking the view that the first and second operator-actuated control means may be construed as either being separate and remotely-located units, or together in the same unit. To clarify the interpretation of these claims, Applicant has amended claims 13 and 26 in the manner suggested by the Examiner to specify that the second control means is "distinct and remotely located from said first operator-actuated control means." Thus, it is believed that this grounds for rejection is now moot.

Applicant also notes that claim 14 is generally similar to claim 26, and claims 25 and 35 are generally similar to claim 13,

although claims 13, 25 and 35 have not been similarly rejected. To expedite the prosecution of this application, amendments similar to those made to claims 13 and 26 have been made to claims 14, 25 and 35.

The Examiner is advised of the current status of the litigation concerning related U.S. Patent No. 5,068,734, *Beery v. Hitachi Home Electronics (America), Inc. et al.*, Case No. 93 4868 DT (Ex). Following the granting of summary judgement in favor of defendants on the basis of non-infringement, an appeal was taken by plaintiff Beery to the Court of Appeals for the Federal Circuit. The CAFC affirmed the district court's grant of summary judgement on November 9, 1995, and a copy of the Court's opinion is enclosed for the reference of the Examiner. A request for reconsideration was filed by Beery, which request was denied on December 19, 1995. A second request for reconsideration is currently in preparation and is expected to be filed.

A fourth supplemental Information Disclosure Statement is submitted concurrently herewith.

In view of the foregoing, it is submitted that claims 1-5, 7-19, 21-28 and 30-56 as amended herein are allowable.

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Reconsideration and allowance of these claims are therefore respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'T.A. Boshinski', written over a horizontal line.

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